



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Dale Du Bois *et al.*

Application No. **10/521,619**

Filed: **July 10, 2003 (International Filing date)**

For: **THERMAL PROCESSING
SYSTEM AND CONFIGURABLE
VERTICAL CHAMBER**

Art Unit: ***To be assigned***

Examiner: ***To be assigned***

Docket No.: **A-71748/MSS (463035-770)**

Date: **October 6, 2006**

Mail Stop MISSING PARTS

Attn: Office of Petitions

Director of the U.S. Patent and Trademark Office

P.O. Box 1450

Alexandria, VA 22313-1450

RENEWED PETITION UNDER 37 C.F.R. § 1.47(A)
(INVENTOR'S REFUSAL TO JOIN)

Sir:

The following is a renewed petition under 37 C.F.R. § 1.47(a) to accept the enclosed Declaration For Patent Application ("Declaration"), which is missing the signature of a joint inventor. This paper is filed in response to the Decision on Petition dated April 6, 2006 received from the United States Patent Office in connection with the above referenced patent application. Accompany this Renewed Petition is an Extension of Time for four months under 37 CFR 1.136(a), with requisite fee, to bring the period of response to October 6, 2006.

A summary of pertinent facts is set forth below. Applicant respectfully requests that the Petition be reconsidered in light of the additional facts set forth below.

The Examiner states that no additional petition fee is due; however the Director is authorized to charge any underpayment of fees, including any necessary fees for extension of time, and/or credit any overpayment to Deposit Account No. 50-2319 (Order No. A-71748/MSS (463035-770)).

The last known address of the non-signing joint inventor is:

Jeffrey Kowalski
122 Zanzibar Road
Aptos, California 95003-5541

STATEMENT OF FACTS

As set forth in the Petition filed on February 6, 2006, the undersigned prepared and filed the present application. In the present application and in this petition, the undersigned represents the interests of Aviza Technology, Inc. ("Aviza").

Upon information and belief, the subject matter of the present application was conceived and developed by Dale R. Du Bois, Jamie H. Nam, Craig Wildman, Taiquing Qiu, and Jeffrey R. Kowalski ("inventors"). On July 10, 2003, PCT application No. PCT/US2003/021575 was filed, directed to the subject matter and naming all inventors (the PCT Application). The PCT Application claims priority to U.S. Provisional Patent Application Serial Nos. 60/396,536 filed July 15, 2002, and Serial No. 60/428,526 filed November 22, 2002 (the Priority Applications). On January 14, 2005 a United States National Phase application was filed under 35 U.S.C. 371 (the present application). At the time of filing of the PCT Application and the Priority Applications, the inventors were employed by and obligated to assign the invention to ASML U.S., Inc. ("ASML").

Subsequently on October 10, 2003, ASML and its parent company ASML Holding N.V. entered into an Asset Purchase Agreement whereby all of the assets, including patents and patent applications, of the Thermal Division were sold to Thermal Acquisition Corporation. The patents and patent applications were assigned to Thermal Acquisition Corporation as shown in the attached assignment document in Exhibit A. Thermal Acquisition Corp. then changed its name to Aviza on October 15, 2003. See Exhibit B.

On January 14, 2005 and February 7, 2005, the undersigned sent the Declaration and Assignment to Ms. Morgan Libby for execution by the inventors. Ms. Libby is the Intellectual Property Administrator for the Applicant. Joint inventors Dale R. Du Bois, Craig Wildman, Jamie Nam, and Taiquing Qiu, have executed the Declaration. Their signed Declaration is attached. Inventor Jeffrey Kowalski has not executed the Declaration.

Ms. Libby informed the undersigned that Mr. Kowalski no longer is employed by Aviza. Ms. Libby informed the undersigned that she requested Mr. Kowalski sign the Declaration and Assignment associated with the present application but that Mr. Kowalski never returned her call and did not sign the papers. Ms. Libby then requested in January 2006 that the undersigned attorney's office attempt to reach Mr. Kowalski and obtain his signature.

On January 17, 2006 the undersigned sent the Declaration and Assignment to Mr. Kowalski at his last known address for execution. In the letter, Mr. Kowalski was asked to sign and return the Declaration and Assignment by January 27, 2006. On January 17, 2006 the undersigned also telephoned Mr. Kowalski at his last known telephone number and left a message indicating the nature and urgency of the matter and requesting his execution of the Declaration and Assignment that was sent to him on the same day. I informed Mr. Kowalski of the final due date of February 5, 2006.

On January 23, 2006 the undersigned again telephoned Mr. Kowalski. This time the undersigned reached Mr. Kowalski on the phone. Mr. Kowalski acknowledged receipt of the Declaration and Assignment. I again informed Mr. Kowalski of the final due date of February 5, 2006. Mr. Kowalski said that he would review the documents and get back to me.

On January 25, 2006, the undersigned's secretary, Kari Aguiar, telephoned Mr. Kowalski to inquire regarding the status of the Declaration and Assignment. Mr. Kowalski did not answer the phone, Ms. Aguiar left him a message requesting his signature on the Declaration and Assignment.

Mr. Kowalski did not sign and return the Declaration or Assignment, nor return the phone calls. On January 27, 2006 the undersigned again forwarded to Mr. Kowalski the Declaration and the Assignment via Federal Express to the above-mentioned last known address. In the letter, Mr. Kowalski was asked to sign and return the Declaration and Assignment by January 30, 2006. Mr. Kowalski did not sign and return the Declaration or Assignment. Copies of the letters sent to Mr. Kowalski are attached in Exhibit C.

On February 1, 2006, February 3, 2006 and February 6, 2006, telephone calls were made by Ms. Aguiar to Mr. Kowalski requesting his signature on the Declaration and Assignment. Mr. Kowalski did not sign and return the Declaration or Assignment.

Additional Facts to Support Renewed Petition: Upon receipt of the Decision on Petition received April 6, 2006, the undersigned contacted Aviza to confirm that it is Aviza's policy to provide the inventors with a copy of the full patent application. Aviza confirmed that it does so. Further, the undersigned, who was involved in preparation of the subject patent application recalls working with Mr. Kowalski and the other inventors during the preparation of the patent application. The undersigned placed phone calls to Mr. Kowalski in an attempt to confirm that Mr. Kowalski did in fact have a copy of the full patent application specification and drawings. In each instance, the undersigned had to leave a voice mail message, and the calls were never returned.

Thus, in order to ensure that Mr. Kowalski was presented with the full patent application papers including the specification and drawings, on September 22, 2006 the undersigned sent another letter to Mr. Kowalski with a copy of the full Patent Application specification and drawings as filed along with another copy of the Declaration and Assignment attached to his last known address. The letter was sent by Express Mail. In the letter, Mr. Kowalski was asked to review the patent application specification and to sign and return the Declaration and Assignment. The undersigned also made a phone call on this day to alert Mr. Kowalski of the documents. Having not heard from Mr. Kowalski, another letter was sent via Express Mail on September 28, 2006, again attaching the full Patent Application specification and drawings as filed along with another copy of the Declaration and Assignment. The letter was marked Urgent. Another phone call was placed, and a message was left indicating the urgency of the matter.

Despite these bona fide attempts to present the full Patent Application specification and figures as filed, the Declaration and Assignment to Mr. Kowalski for his execution, Mr. Kowalski has not returned a signed copy of the Declaration or Assignment.

Mr. Kowalski is obligated by agreement to assign his entire interest in the subject matter of the present application to ASML, which sold and assigned the entire interest to Aviza.

CONCLUSION

Applicants respectfully submit that Jeffery Kowalski's conduct constitutes a refusal to join the application and thus Applicants submit this petition under 37 C.F.R. § 1.47(a).

Applicants, that is, joint inventors Dale R. Du Bois, Craig Wildman, Jamie Nam and Taiquing Qiu petition to make this application on behalf of themselves and of the nonsigning, joint inventor Jeffrey Kowalski, who refuses to join in the present application.

In accordance with M.P.E.P. § 409.03(a)(A)(2), the Declaration is signed by all available joint inventors with the signature blocks of the non-signing inventor left blank. Applicants petition to have the Declaration be treated as having been signed by all the available joint inventors on behalf of the non-signing inventor.

Applicants respectfully submit that a filing date for the present application is necessary to preserve Applicants' rights, and that denial of this petition would result in irreparable damage to Applicants. In particular, the filing date of the present application is necessary to preserve the claimed benefit of the provisional application.

Respectfully submitted,

Date: October 6, 2006

By: 

Maria S. Swiatek, Reg. No. 37,244

Customer No. 32940
DORSEY & WHITNEY LLP
555 California Avenue
Suite 1000
San Francisco, CA 94104-1513
Telephone: (415) 781-1989
Facsimile: (415) 398-3249

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Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**STATEMENT OF FACTS BY MARIA SWIATEK TO SUPPORT
RENEWED PETITION UNDER 37 C.F.R. § 1.47(A)**

Sir:

On January 14, 2005 and February 7, 2005, I sent the Declaration and Assignment to Ms. Morgan Libby for execution by the inventors in connection with the above referenced patent application. Ms. Libby is the Intellectual Property Administrator for the Applicant. Joint inventors Dale R. Du Bois, Craig Wildman, Jamie Nam, and Taiquing Qiu, have executed the Declaration. Their signed Declaration is attached. Inventor Jeffrey Kowalski have not executed the Declaration.

Ms. Libby informed me that Mr. Kowalski no longer is employed by Aviza. Ms. Libby informed me that she requested Mr. Kowalski sign the Declaration and Assignment associated with the present application but that Mr. Kowalski never returned her call and did not sign the papers. Ms. Libby then requested in January 2006 that I attempt to reach Mr. Kowalski and obtain his signature.

On January 17, 2006 I sent the Declaration and Assignment to Mr. Kowalski at his last known address for execution. In the letter, Mr. Kowalski was asked to sign and return the Declaration and Assignment by January 27, 2006. On January 17, 2006 I also telephoned Mr. Kowalski at his last known telephone number and left a message indicating the nature and urgency of the matter and requesting his execution of the Declaration and Assignment that were sent to him on the same day. I informed Mr. Kowalski of the final due date of February 5, 2006.

On January 23, 2006 I again telephoned Mr. Kowalski. This time I reached Mr. Kowalski and spoke with him on the phone. Mr. Kowalski acknowledged to me that he received the Declaration and Assignment. I again informed Mr. Kowalski of the final due date of February 5, 2006. Mr. Kowalski said that he would review the documents and get back to me.

On January 25, 2006, I directed my secretary, Kari Aguiar, to telephone Mr. Kowalski to inquire regarding the status of the Declaration and Assignment. Mr. Kowalski did not answer the phone, Ms. Aguiar left him a message requesting his signature on the Declaration and Assignment.

Mr. Kowalski did not sign and return the Declaration or Assignment, nor return the phone calls. On January 27, 2006 I again forwarded to Mr. Kowalski the Declaration and the Assignment via Federal Express to the above-mentioned last known address. In the letter, Mr. Kowalski was asked to sign and return the Declaration and Assignment by January 30, 2006. Mr. Kowalski did not sign and return the Declaration or Assignment. Copies of the letters sent to Mr. Kowalski are attached in Exhibit C.

On February 1, 2006, February 3, 2006 and February 6, 2006, telephone calls were made by Ms. Aguiar to Mr. Kowalski requesting his signature on the Declaration and Assignment. Mr. Kowalski did not answer, and Ms. Aguiar left messages each time. On February 6, 2006 I again telephoned Mr. Kowalski requesting his signature of the Declaration and Assignment. Mr. Kowalski did not sign and return the Declaration or Assignment. Mr. Kowalski did not return my call.

Upon receipt of the Decision on Petition received April 6, 2006, I contacted Aviza to confirm that it is Aviza's policy to provide the inventors with a copy of the full patent application. Aviza confirmed that it does so. Further, I was involved in preparation of the

subject patent application and recall working with Mr. Kowalski and the other inventors during the preparation of the patent application. I placed phone calls to Mr. Kowalski in an attempt to confirm that Mr. Kowalski did in fact have a copy of the full patent application specification and drawings. In each instance, I had to leave a voice mail message, and the calls were never returned.

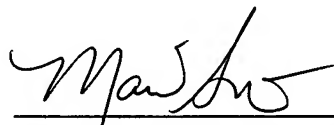
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Despite these efforts, I have not received the Declaration and Assignment executed by Mr. Kowalski.

Respectfully submitted,

Date: October 6, 2006

By:



Maria S. Swiatek, Reg. No. 37,244

Customer No. 32940
DORSEY & WHITNEY LLP
555 California Avenue
Suite 1000
San Francisco, CA 94104-1513
Telephone: (415) 781-1989
Facsimile: (415) 398-3249

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